

REMARKS

In response to the Office Action mailed November 3, 2005 in the above-identified application, Applicants respectfully request consideration. To further the prosecution of this application, each of the issues raised in the Office Action is addressed herein.

Claims 9, 13-25, 43-45, 50, 51, 72-74, 76, 81, 93-106, 109-116, 120-125 and 128-132 are pending in this application, of which claims 9, 14, 93, 109, 111 and 121 are independent claims. In this response, claims 9, 14, 50, 76, 81, 99-106, 109, 111, 112, 116, 120, 122, 124, 125 and 128-131 have been amended, and claims 77-80, 107, 108, 117-119, 126 and 127 have been cancelled without prejudice or disclaimer. No new matter has been added. The application as now presented is believed to be in allowable condition.

Applicants note that on page 2 of the Office Action, claims 99 and 122, and the claims dependent thereon, were withdrawn from consideration as being directed to a non-elected invention, pursuant to a constructive election by original presentation. In this amendment, claims 99 and 122 have been amended to depend from claims 9 and 109, respectively. Hence, claims 99 and 122, and the claims dependent thereon, are entitled to further consideration as dependent upon elected independent claims that are believed to be in allowable condition, as discussed in detail below in Section C.

A. Allowed Claims/Allowable Subject Matter

Applicants note with appreciation that on page 6, the Office Action indicates that claims 93-98 are allowed, and that claims 14, 15, 74 and 111 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of their respective base claims and any intervening claims.

In view of the foregoing, Applicants have rewritten claims 14 and 111 in independent form to include all of the limitations of their respective base claims 9 and 109, respectively. Accordingly, claims 14 and 111 are believed to be in allowable condition. Claim 15 depends from claim 14 and is allowable based at least upon its dependency.

At this time, Applicants have not rewritten dependent claim 74 in independent form, but reserve the right to do so in the future if deemed necessary.

In connection with allowed claim 93, Applicants note that independent claim 121 is a method claim that closely tracks the language of system claim 93. Accordingly, claim 121 is believed to be allowable for at least the same reasons as claim 93.

B. Informalities

On page 3 of the Office Action, claim 112 was rejected under 35 U.S.C. §112 for alleged indefiniteness issues, and claim 50 was objected to for a typographical error. The amendments herein are believed to address both of these issues.

C. Claim Rejections under 35 U.S.C. § 103(a)

On page 3 of the Office Action, claims 9, 13, 16-25, 43-45, 50, 51, 72, 73, 109, 110, 112-115 and 121 (including independent claims 9, 109 and 121) were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Chliwnyj (U.S. Patent No. 5,924,784) in view of Post (U.S. Patent No. 5,187,655). Applicants respectfully traverse these rejections. Applicants note that this rejection is indicated in the Office Action as a rejection under 35 U.S.C. §102(e), but proceed under the assumption that this indication is an inadvertent typographical error in the Office Action.

1. The Combination of Chliwnyj and Post Fails to Establish a *Prima Facie* Case of Obviousness

As set forth in MPEP §2143, three criteria must be met in order to establish a *prima facie* case of obviousness. First, the prior art references, when viewed as a whole, must teach or suggest all of the claimed features. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the cited references or to combine reference teachings. Third, there must be a

reasonable expectation of success. The teachings or suggestion to modify the references or to combine reference teachings, as well as the reasonable expectation of success, must both be found in the prior art and not based on Applicants' disclosure. Failure to meet any one of these criteria is sufficient to establish the impropriety of an obviousness rejection.

Neither Chliwnyj nor Post, when viewed alone or in combination, teaches or suggests all of the limitations recited in Applicants' independent claims 9, 109 and 121. Furthermore, neither Chliwnyj nor Post provides any teaching, suggestion, or motivation to combine these references in any manner. Moreover, the Office Action fails to specify any reasonable or compelling motivation to combine these references, and completely fails to discuss the reasonable expectation of success in making such a combination.

Instead, on page 4, the Office Action merely alleges that:

It would have been obvious to one having ordinary skill in the art at the time of applicant's claimed invention was made to have employed the user interface (encoder) as taught by Post et al as it would have initiated the processor into selecting a program from the memory as well as changing a program and program parameter upon receipt of the encoder signal....

The Office Action merely expresses an alleged result of employing a feature of Post in the disclosure of Chliwnyj. Beyond this, however, the Office Action fails to specify any indication, either in the references themselves or in the knowledge generally available in the art, of any motivation or reasonable expectation of success in combining the selected features of Post with the teachings of Chliwnyj. Most notably, the Office Action completely fails to specify or suggest in any manner *how* one of ordinary skill in the art would practically and realistically combine the specified elements of Chliwnyj and Post to successfully arrive at something that would resemble the subject matter of Applicants' claims.

In view of the foregoing, the Office Action fails to establish a *prima facie* case of obviousness based on the combination of Chliwnyj and Post, as at least one claimed feature in each of Applicants' independent claims, a motivation to combine the cited references and a

reasonable expectation of success in modifying reference teachings all are lacking. Accordingly, the combination of Chliwnyj and Post is improper, and therefore the rejections of claims 9, 13, 16-25, 43-45, 50, 51, 72, 73, 109, 110, 112-115 and 121 under 35 U.S.C. §103(a) should be withdrawn.

Following below are summaries of the Chliwnyj and Post references, as well as a more detailed discussion of the impropriety of the combination of these references.

2. The Combination of Chliwnyj and Post Fails to Teach All of the Claimed Features

a. Chliwnyj

Chliwnyj is concerned primarily with providing an electronic lighting device that simulates a realistic flame (col. 2, lines 26-53). To this end, Chliwnyj teaches a solution in which a control circuit modulates the respective intensities of a plurality of differently colored lighting elements. The control circuit operates according to a pre-determined stored program, which contains specific pre-defined elements that generate a constantly changing flame having realistic, random characteristics. Various effects (e.g. such as a random gust of wind) and flame types are achieved by controlling the frequency of intensity modulation for the lighting elements pursuant to the pre-determined stored programs. In order to simulate a real flame, these modulations specified by the program are “continuous and not abrupt” (col. 7, lines 55-57).

b. Post

Post is concerned primarily with providing portable devices for controlling a lighting system that provides ambient white lighting. Post is not concerned with the lights or lighting system itself but rather merely providing a control mechanism for the lighting system. To this end, Post discloses a hand-held programmer for adjusting various functions of a multi-scene, multi-zone programmable ambient lighting system. The hand-held programmer device includes push-buttons for selecting particular scenes and zones. In addition, the user may actuate the

push-buttons to adjust any one of the following functions: intensity, fade time and fade delay of the lighting zones (col. 4, lines 54-68). In sum, the portable programmer of Post controls various dimming functions in a white-light environment.

c. Independent Claims 9 and 109

Applicants' amended claim 9 recites, *inter alia*, the selection of a program from a memory upon the receipt of a user interface signal, in which "the program, when executed by the processor, controls at least a color of the variable color radiation." Claim 109 is a method claim that closely tracks the language of claim 9, and also recites, *inter alia*, selecting a program from a memory upon the receipt of a user interface signal and "executing the program to generate the at least one signal communicated by the processor so as to control at least a color of the variable color radiation."

Nowhere in the reference does Chliwnyj disclose or suggest a user-selected program that "when executed by the processor, controls at least a color of the variable color radiation." In fact, the Office Action acknowledges on page 4 that Chliwnyj does not "explicitly disclose a user interface [that] supplies a logic high or low signal to the processor."

Applicants agree with this assessment, and further note that although Chliwnyj briefly discloses an embodiment in which a user may vary a brightness of the overall light generated by the simulated flame device (col. 14, lines 11-43), nowhere does Chliwnyj disclose or suggest a user-selected program that "when executed by the processor, controls at least a color of the variable color radiation."

Post also fails to disclose or suggest this feature. In fact, Post does not even disclose multi-colored lighting elements, much less a user-selected program that "when executed by the processor, controls at least a color of the variable color radiation."

For at least the foregoing reasons, Applicants' claim 9 and 109 patentably distinguish over Chliwnyj and Post and are in condition for allowance.

Claims 13, 15-25, 43-45, 50, 51, 72-74, 76, 81, 99-106, 110, 112-116, 120 and 122-132 depend from one of claims 9 and 109, and hence are allowable based at least upon their dependency.

d. Allowability of Claim 121

As mentioned above, Applicants note that independent claim 121 is a method claim that closely tracks the language of system claim 93. Thus, claim 121 is believed to be allowable for at least the same reasons as claim 93.

3. There is No Motivation to Combine Chliwnyj and Post and No Reasonable Expectation of Success

As described above, Chliwnyj and Post address two unrelated problems and solve their respective problems by unrelated solutions.

First, Chliwnyj is concerned primarily with solving the problem of providing electronic lighting devices that simulate a realistic flame. Chliwnyj teaches a solution in which a control circuit modulates the specific intensities of a plurality of lighting elements in accordance with a pre-defined program. However, in order to simulate a real flame, the changes between the programs must be seamless and continuous. In fact, Chliwnyj explicitly teaches away from having an "abrupt" change between the program elements (col. 7, lines 55-57). Accordingly, the automated aspect of the programs, in large part, helps Chliwnyj to achieve a seamless transition between the various lighting effects constituting a realistic simulated flame.

In contrast to Chliwnyj, Post is concerned primarily with providing a portable device for programming a lighting system that provides ambient light. Post provides a solution in which a hand-held programmer allows for control of a number of lighting zones in a number of different areas. By depressing a button on the hand-held device, a user immediately activates a corresponding lighting zone within the lighting system. While this method of implementation

provides convenience to the user, Post's method, unlike Chliwnyj, does not provide a seamless transition between lighting programs or lighting states. In fact, Post explicitly teaches a "zone-finder" function in which the selected zone flashes "on and off" in order to assist the user in locating the zone (col. 2, lines 34-40). This function explicitly teaches away from Chliwnyj's purpose of having a seamless, imperceivable, transition between the various lighting effects.

For at least the foregoing reason, one of ordinary skill in the art simply would have no motivation, based on the references themselves or the knowledge generally available to those skilled in the art, to combine Chliwnyj and Post in the manner suggested by the Examiner.

Finally, it is noteworthy that the Office Action fails to provide any support for practically and realistically applying any features of Post to modify Chliwnyj, nor does the Examiner provide any example of a reasonable expectation of success in making any such modification. Instead, the Office Action merely provides a general assertion of an alleged motivation to combine the references, without any specific support.

In view of the foregoing, it is entirely unclear from the Chliwnyj and Post references how the different elements of these references would realistically be combined to provide a viable functioning device. Not only do the references, when viewed as a whole, fail to provide any such teaching, suggestion or motivation, but furthermore the Office Action provides no insight as to how to practically and successfully implement such a combination.

For the foregoing additional reasons, the Office Action further fails to establish a *prima facie* case of obviousness. In sum, the Office Action fails to meet all three of the obviousness criteria set forth in MPEP §2143. Therefore, the combination of Chliwnyj and Post is improper. Thus, again the rejections of claims 9, 109 and 121 under 35 U.S.C. §103(a) as allegedly being obvious over Chliwnyj in view of Post should be withdrawn.

Claims 13-25, 43-45, 50, 51, 72-74, 76, 81, 99-106, 110-116, 120, 122-125, and 128-132 depend from one of claims 9 and 109, and hence are allowable based at least upon their dependency.

4. Rejections Based on Alleged Inherency

On page 5 of the Office Action, all of the method claims, including independent method claims 109 and 121 and any claims dependent thereon, were summarily rejected in a brief statement alleging that “the claimed method is inherent in the Chliwnyj et al. and Post et al. combination.” As discussed above, the combination of Chliwnyj and Post is believed to be improper for several reasons. However, even if such a combination were proper, which it is not, the sweeping assertion that the method claims are alleged inherent in the cited combination clearly is improper, and completely fails to meet the requirements for sustaining any rejection based on inherency.

With respect to rejections based on inherency or implicit disclosure, MPEP §2112(IV) states that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Rather, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (emphasis in original)(citations omitted).

In view of the foregoing requirements set forth in MPEP §2112(IV), the Office Action plainly fails to meet these requirements for supporting any rejection based on inherency. Instead, the Office Action makes the bare allegation that the method claims are inherent in the cited combination, and the discussion summarily ends there. There is no attempt to even minimally support the inherency rejections. For at least this reason, the rejections of method claims 109, 121, and any dependent claims thereon are improper and should be withdrawn.

D. General Comments on Dependent Claims

Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicants believe that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. However, Applicants do not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor do Applicants concur that the basis for the rejection of any of the dependent claims is proper. Therefore, Applicants reserve the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

E. Conclusion

In general, the absence of a reply to a specific rejection, issue or comment set forth in the Office Action does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Furthermore, nothing in this paper should be construed as an intent to concede any issue with regard to any claim.

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' representative at the telephone number indicated below to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, please charge any deficiency to Deposit Account No. 06-1448, Reference CKB-015.01.

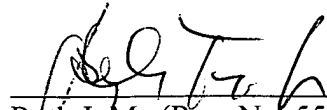
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